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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/252,485	02/18/1999	JOHN S. HENDRICKS	5615	4559

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PATTERSON & SHERIDAN, LLP/
SEDNA PATENT SERVICES, LLC
595 SHREWSBURY AVENUE
SUITE 100
SHREWSBURY, NJ 07702

EXAMINER

LONSBERRY, HUNTER B

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/252,485	Applicant(s) HENDRICKS ET AL.	
	Examiner Hunter B. Lonsberry	Art Unit 2611	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see below.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
 13. ☐ Other: _____.

continued from above:

Applicant argues that there is support for POP functionality on an expansion card, in that the specification states that expansion cards may be designed to accommodate any hardware upgrade compatible with the STB, that POP capabilities are considered to be upgraded hardware components (page 12)

Regarding applicant's argument, Page 44, lines 22-25, states that

"The use of expansion cards lowers the cost of the set top terminal 220 itself, while also increasing its potential functionality. Thus, an expansion card may include enhanced functional capabilities described as part of the upgrade module discussion above and be designed to accommodate any hardware upgrade compatible with the set top terminal 220."

The examiner notes that the discussion on page 44, lines 21-25 is in reference to figures 5a/b having expansion card slots, and is silent with regards to expansion cards and picture on picture capabilities. There is no correlation with any of the components of figure 14, and Figures 5 a/b do not show an upgrade card of any kind, but merely an upgrade port 664. Further, the examiner has reviewed pages 43-44 and 49-51 and figure 14 of applicant's specification, regarding the second signal components (603', 606', 609', 314', 318', 616', etc). It appears as though the ' marker delineates a first and second component, and in no where does it refer to ' marked components as being located on a set top upgrade card. Figure 14 does disclose the use of an expansion card interface 322, and upgrade port 662, but none of the ' marked components show any coupling through either interface 322 or port 662 (nor is there any discussion there of), rather they are shown as being linked through microprocessor 602.

Additionally, neither the specification, nor the drawings describe the boundary, contents or components of the upgrade hardware in relation to figure 14. Therefore, all of the ' marked components must be part of the set top device itself.


The examiner also notes that Figures 12 a/b while directed to hardware upgrades A-E, are not directed to a video hardware upgrade which enables picture in picture presentations, rather figure 12b, is directed towards a digital audio tuner, with not mention of a video tuner, Figure 12a, is directed to computing component upgrades (page 41, lines 4-29, page 42, lines 18-22).

Likewise Page 49, lines 11-15 reads, "Although the preferred embodiment of the present invention decompresses one channel at a time for the viewer, users who desire a picture-on-picture capability can be provided with a set top terminal 220 having upgraded hardware components that allow two or more channels to be tuned and decompressed at any given time. Once two signals are available, the picture-on-picture capability can be made fully available in the set top terminal 220, without requiring a special television or a VCR." The examiner notes that the above passage states that set top terminal 220 has upgraded hardware components. The above disclosure is absolutely silent regarding the use of an upgrade card, likewise it is silent as to which components constitute the upgrade card and which components constitute the set top box. The disclosure is silent as to whether the upgraded components reside on an expansion card, or constitute hardware portions of the set top box itself. Even if an expansion card was utilized in the system for delivering picture on picture capability, one skilled in the art at the time of invention based solely upon applicants disclosure would not be able to make and use the invention as they would not be able to determine which components constitute the hardware upgrade and which components constitute the set top box, because Figure 14 and the supporting disclosure fail to support claims 42-43, 46-54, 57, 60-64, 74 and 79.

Applicant argues that the combination of Arai, Wasilewski and Ryu fails to teach the use of an upgrade card inserted into an STB or any upgrade ports (pages 10-11).

Regarding applicant's argument: in the previous Office Action the Examiner combined Arai (of record) in view of Willis (of record) and further in view Ryu (of record). Moreover, it would have been obvious to one of ordinary skill in the art to provide the functions on an upgrade card since the modification would have involved a mere separation of functions/parts and applicant did not provide any specific benefit, nor stated that it solve any specific problem *Nerwin V. Erlichman*, 168 USPQ 177, 179 (PTO Bd. of Int. 1969). The cited passage within Applicants' specification does state that upgrade cards prolong the useable life of the set top terminal as well as give them flexibility of use. However, the use of upgrade cards or connection of external devices in the electrical devices art is notoriously well known in order to provide increased flexibility and extending the useful life of a device. Numerous examples within the electrical device art include memory upgrades allow for more storage of data on a device than its default capabilities, SCSI expansion cards allow for the connection of data storage devices, modem cards allow for telecommunications exchanges, gaming ports on video game devices allow for new peripherals to be attached which establish new capabilities (paddle controllers on an Atari 2600, hardware cards which allow Atari 2600 games to be played on an Atari 5200), upgrades to the Atari arcade game Star Wars which enables a daughter board to be attached to play an Empire Strikes Back game (which prolongs the useable life of the electronic device) etc. The use of upgrade cards to which prolong the useable life of a device and provide flexibility of use predates applicants invention.

Therefore, the combination of Arai, Willis, and Ryu in combination with the hardware upgrade teachings does teach every aspect of applicant's claimed invention.


CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600